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EXAMINER

NGUYEN, MINH DIEU T

ART UNIT PAPER NUMBER

2137

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/530,334

Applicant(s)

ROVER ET AL.

Examiner

Minh Dieu Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 13-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 November 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the communication dated March 21, 2005 with the amendments to claims 13 and 16-20; the addition of claims 22-48 and the cancellation of claims 1-12.

Claims 13-48 are pending.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 13-21 have been considered but are moot in view of the new ground(s) of rejection. Applicant's arguments focus on the combination of features introduced by the amendment with elements that already existed in the claims. The new material is rendered obvious by Jonstromer (6,142,369) and Kawan (5,796,832).

### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: the drawings need text, there is no suitable descriptive legend for the drawings. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet

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submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

4. The disclosure is objected to because of the following informalities:

On page 5, line 27, "receiver 3" should be "receiver 5" according to drawing Fig.

1.

On page 6, line 16 and line 18, "chipcard means 27" should be "chipcard means 17" according to drawing Fig. 2.

On page 6, line 24, "chipcard 27" should be "chipcard 25" according to Fig. 3.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 13 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 13 and 34 recite the limitation "transmitting a message to be signed to a receiver" and another limitation "transmitting the signed message to at least one receiver". There is insufficient antecedent basis for "at least one receiver" limitation in the claims.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 13-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jonstromer (6,142,369) in view of Kawan (5,796,832).

a) As to claim 13, 21, 22, 34 and 39, Jonstromer discloses a method for conducting electronic financial transactions using a smart card comprising the step of signing the message to be signed via the mobile radio telephone, thereby forming a signed message, the signed message signifying a user's intent to deliver the signed message and its content; the step of transmitting the signed message to at least one receiver (col. 3, lines 50-53, i.e. the communications module is a mobile phone, adapted to receive a smart card wherein the smart card may be arranged to act as a SIM for the mobile phone (col. 2, lines 25-29), the communication module transmits a signed message (i.e. amount to be transferred, electronic signature of payer). The signed

message signifies user's intent to deliver the signed message and its content (i.e. the address of the payee, the account number) and the step of communicating the signed message to an addressee (col. 3, lines 58-59).

Jonstromer discloses the mobile radio telephone comprising a signing unit (col. 1, lines 28-44; col. 4, lines 38-44). However, Jonstromer does not disclose the step of transmitting a message to be signed to a receiver and the receiver transmits the message to be signed to a mobile radio telephone via a telephone network.

Kawan discloses a system for providing financial information and performing financial transactions comprising transmitting from a transmitter a message to be signed to a receiver (Fig. 2B; i.e. requests are sent from various nodes 58, 60, 62 and 64 to financial server/institution); transmitting the message to be signed from the receiver via a telephone network to a mobile radio telephone (Fig. 2C; i.e. a cell phone serves as a financial information and transaction terminal, this cell phone functions like Fig. 2B, element 54).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of transmitting a message to be signed to a receiver and the receiver transmits the message to be signed to a mobile radio telephone in the system of Jonstromer as Kawan teaches so as to provide a flexible way of presenting messages to be signed rather than a precise data entering in the phone system to be signed.

b) As to claims 14, 25, 35, 40 and 42, Jonstromer discloses the public key process is used for signing (col. 4, lines 47-52), particularly a public key process in

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which the signing unit has an associated secret key (col. 4, lines 37-41) and , in particular, the receiver has a corresponding public key so that the signed message transmitted to the receiver can, optionally, be compared with the original message and identified as authentic (col. 6, lines 36-41).

c) As to claims 15, 26 and 36, Jonstromer discloses transmission over GSM system (col. 1, lines 39-41), it is inherently understood that the short message service is used in GSM communications for sending short messages to mobile phones.

d) As to claims 16 and 27, Jonstromer discloses the message to be signed is displayed by means of a display provided in the mobile radio telephone (Figure 2C, element 78).

e) As to claims 17 and 28, Jonstromer discloses the secret key required for signing is inputted via keyboard on the mobile radio telephone (col. 1, lines 28-44).

f) As to claims 18 and 29, Kawan discloses the secret key is stored on a smart card which is inserted into the mobile radio telephone (col. 4, lines 19-32), the secret key is activated by a PIN adapted to be inputted via a keyboard on the mobile radio telephone (col. 5, lines 1-9).

g) As to claims 19, 20, 23-24 and 30-31, Jonstromer discloses the mobile radio telephone performs the signing step (col. 3, lines 50-53) and the secret key is read from the chipcard (col. 1, lines 28-44).

h) As to claim 32, Jonstromer discloses the signing apparatus serves in addition as a transmitter to transmit the signed message to the receiving device (col. 3, lines 50-53).

i) As to claim 33, Jonstromer discloses a chipcard for a mobile telephone (col. 2, lines 25-29), wherein the chip card incorporates a signing device which has a memory unit for storing a private key necessary for producing a signed message (col. 1, lines 18-44). Jonstromer does not disclose the signed message is generated from a message to be signed which is received by the mobile telephone via a telephone network.

Kawan discloses a system for providing financial information and performing financial transactions comprising transmitting the message to be signed from the receiver via a telephone network to a mobile radio telephone (Fig. 2C; i.e. a cell phone serves as a financial information and transaction terminal, this cell phone functions like Fig. 2B, element 54).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of transmitting a message to be signed to a receiver and the receiver transmits the message to be signed to a mobile radio telephone in the system of Jonstromer as Kawan teaches so as to provide a flexible way of presenting messages to be signed rather than a precise data entering in the phone system to be signed.

j) As to claim 37, Kawan discloses the receiver provides a gateway function for interoperability between a protocol for the transmitting from a transmitter a message to be signed to a receiver and a protocol for the transmitting the message to be signed from the receiver via a telephone network to a mobile radio telephone (Fig. 2B).



k) As to claim 38, Kawan discloses at least one receiver provides a gateway function for interoperability between a protocol for transmitting the corresponding signed message from the mobile radio telephone to the some other receiver and a protocol for the communicating the corresponding signed message to an addressee (Fig. 4).

l) As to claim 41, Jonstromer discloses a method for conducting electronic financial transactions using a smart card comprising the step of generating a corresponding signed message and transmitting the signed message (col. 3, lines 50-53, i.e. the communications module is a mobile phone, adapted to receive a smart card wherein the smart card may be arranged to act as a SIM for the mobile phone (col. 2, lines 25-29), the communication module transmits a signed message (i.e. amount to be transferred, electronic signature of payer). Jonstromer discloses the mobile radio telephone comprising a signing unit (col. 1, lines 28-44; col. 4, lines 38-44). However, Jonstromer does not disclose the step of receiving the message and displaying at least a portion of the message and accepting input from the user indicating the received message is to be signed.

Kawan discloses a system for providing financial information and performing financial transactions comprising transmitting from a transmitter a message to be signed to a receiver (Fig. 2B; i.e. requests are sent from various nodes 58, 60, 62 and 64 to financial server/institution); transmitting the message to be signed from the receiver via a telephone network to a mobile radio telephone (Fig. 2C; i.e. a cell phone serves as a financial information and transaction terminal, this cell phone functions like Fig. 2B, element 54), displaying the message (Fig. 2C, element 78) and accepting input from the

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user indicating the received message is to be signed (i.e. the secret key is stored on a smart card which is inserted into the mobile radio telephone (col. 4, lines 19-32), the secret key is activated by a PIN adapted to be inputted via a keyboard on the mobile radio telephone (col. 5, lines 1-9)).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of transmitting a message to be signed to a receiver and the receiver transmits the message to be signed to a mobile radio telephone in the system of Jonstromer as Kawan teaches so as to provide a flexible way of presenting messages to be signed rather than a precise data entering in the phone system to be signed.

m) As to claims 43-44 and 48, Jonstromer discloses the memory for storing the algorithm is located within a chip card of the wireless device (col. 1, lines 28-44, i.e. chipcard acts as a SIM for the mobile phone, SIM carries a variety of information including asymmetric ciphers, keys for encryption and electronic signing).

n) As to claims 45 and 47, Jonstromer discloses the wireless device is a mobile radio telephone (Fig. 1, element 4).

o) As to claims 46, Jonstromer discloses a wireless device for receiving a message to be signed and transmitting a corresponding signed message (Fig. 2), the device comprising an antenna for receiving and transmitting messages (Fig. 2, element 8); a display for displaying a received message (Fig. 2, element 6); memory for storing an algorithm for generating a corresponding signed message (col. 1, lines 28-44, i.e.

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chipcard acts as a SIM for the mobile phone, SIM carries a variety of information including asymmetric ciphers, keys for encryption and electronic signing).

Kawan discloses an antenna for receiving and transmitting messages (Figs. 2B and 2C; cell phone acts as a financial information and transaction terminal) and input apparatus for accepting input from a user indicating the received message is to be signed (i.e. the secret key is stored on a smart card which is inserted into the mobile radio telephone (col. 4, lines 19-32), the secret key is activated by a PIN adapted to be inputted via a keyboard on the mobile radio telephone (col. 5, lines 1-9)).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of transmitting a message to be signed to a receiver and the receiver transmits the message to be signed to a mobile radio telephone in the system of Jonstromer as Kawan teaches so as to provide a flexible way of presenting messages to be signed rather than a precise data entering in the phone system to be signed.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dieu Nguyen whose telephone number is 571-272-3873. The examiner can normally be reached on M-F 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

Minh Dieu Nguyen  
Examiner  
Art Unit 2137

mdn  
6/3/05



ANDREW CALDWELL  
SUPERVISORY PATENT EXAMINER